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## REMARKS

This reply is in response to the Office Action mailed on August 10, 2006 in which claims 1-21 were rejected. Claims 1, 5, 6, 12 and 15 are amended. Claims 22-25 are added. Claims 1-25 are presented for reconsideration and allowance.

I. Rejection of Claims 12-15 and 21 under 35 USC 101

Claims 12-15 and 21 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In response, claims 12 and 21 are each amended to recite that the means are embodied at least in part in a computer readable medium. Accordingly, claims 12-15 and 21, as amended, overcome the rejection.

II. Rejection of Claims 1-13 and 15-21 under 35 USC 102(e) Based upon Tafoya

Section 4 of the Office Action rejected claims 1-13 and 15-21 under 35 USC 102(e) as being anticipated by Tafoya et al. US Patent 6,829,607. Claims 1-13 and 15-21, as amended, overcome the rejection based upon Tafoya.

## A. Claim 1

Independent claim 1, as amended, recites a method of populating a contact list on a portable device and recites:

extracting contact information from a number of messages stored in a memory in the portable device; and

automatically entering the extracted contact information upon extraction into a contact list maintained by a program operating on the portable device.

Tafoya fails to disclose a method wherein contact information from a number of messages is extracted and is automatically entered upon extraction into a contact list. In contrast, Tafoya extracts information and enter such information into a resolution list, not a contact list. A resolution list is not the same as a contact list. Tafoya itself makes this distinction clear. Tafoya repeatedly refers to its "resolution list" as being distinct from its

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"address book"/"contact listings"/"contact database". (See Tafoya, column 4, line 50-52; column 7, lines 31-35; 11, lines 23-25; column 13, lines 6-7; lines 24-29 and lines 32-34).

Moreover, although Tafoya does disclose that a user may selectively add resolution list entries to his or her address book or contact database, nowhere does Tafoya disclose automatically entering extracted contact information upon extraction into a contact list. Rather, Tafoya apparently requires an individual to go to the additional effort of (1) browsing the resolution list and (2) manually selecting such entries to be added to the contact list via a "push-button". (See Tafoya, column 13, lines 18-29).

One of the main objectives of Tafoya appears to be user convenience. As acknowledged by Tafoya, many e-mail users do not take the time to enter information into their e-mail address books/contact lists (see Tafoya, column 1, lines 63-65). If the user will not take the time to enter information into their contact list, the user will also probably not take the time to transfer information from Tafoya's resolution list to their contact list. Tafoya fails to recognize that additional convenience may be achieved by automatically entering extracted contact information upon extraction into a contact list as Applicants have realized.

Moreover, Tafoya actually teaches away from automatically entering extracted contact information upon extraction into a contact list. As noted by Tafoya, any contact information already contained in the contact list is removed from the resolution list. (See Tafoya, column 13, lines 27-29). To hypothetically and alternatively automatically enter extracted contact information upon extraction into the contact list of Tafoya would eliminate Tafoya's resolution list. The entire focus of Tafoya is its resolution list. As noted by MPEP 2143.02, **THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE and THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE.** Since modifying Tafoya to alternatively automatically enter extracted contact information upon extraction into a contact list would substantially change the principle of operation of Tafoya, it would not be obvious to modify Tafoya in such a manner. Accordingly, Claim 1, as amended, overcomes the rejection based upon Tafoya. Claims 2-10 depend from claim 1 and overcome the rejection for the same reasons.

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**B. Claim 5**

Claim 5 depends from claim 1 intervening claim 4. Claim 5, as amended, recites that only messages sent or received before a preselected time stamp, after a preselected timestamp or during a preselected time period between two timestamps are scanned for contact information extraction. Support for the amendment to claim 5 may be found in at least Paragraph [0038]. Thus, no new matter is added.

Tafoya fails to disclose that only messages sent or received before a preselected timestamp, after a preselected timestamp or during a preselected time period between two timestamps are scanned. In contrast, Tafoya requires the entire "data store" to be scanned each time the program information module (PIM) is started. (See Tafoya, column 9, lines 53-56). Thereafter, as a user enters new e-mail addresses while the PIM is active, the resolution list is updated. Tafoya does not disclose scanning a message database for contact information extraction based upon timestamps of the messages. Accordingly, claim 5, as amended, overcomes the rejection based upon Tafoya.

**C. Claim 6**

Claim 6 is amended to depend from claim 4 which depends from claim 1. Claim 6 recites that only messages sent or received after a time of a last scan are scanned.

Tafoya does not disclose a method wherein only messages sent or received after a time of a last scan are scanned for contact information extraction. In rejecting claim 6, the Office Action asserts that "after the program is started only new entries are dynamically scanned, Col.9, lines 61-63)." This assertion is incorrect. As noted above, Tafoya requires the entire "data store" to be scanned each time the program information module (PIM) is started. (See Tafoya, column 9, lines 53-56). Moreover, the portion of Tafoya decided by the Office Action specifically states:

(1)In addition, (2) as the user enters new e-mail addresses or contact information in an e-mail message, or as new e-mail messages having e-mail addresses or contact information are received, that information is also used by the PIM to dynamically update the resolution list.

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(Emphasis added) (Tafoya, column 9, lines 59-63). Applicants respectfully note that this dynamic updating of the resolution list is in addition to the already performed complete scan of the entire "data store". Moreover, this statement specifically refers to "as the user enters new e-mail addresses ... or as new e-mail messages ... are received". Such new outgoing e-mail messages or incoming e-mail messages are not disclosed as being scanned from a message database. Accordingly, claim 6, as amended, overcomes the rejection based upon Tafoya.

D. Claim 12

Independent claim 12, as amended, is directed to a user interface in a portable device configured to facilitate the populating of a contact list and recites, among other limitations:

means for extracting contact information from a number of messages stored in a memory in the portable device; ....

means for presenting the extracted contact information from a plurality of the number of messages at once on the portable device prior to any storing of the extracted contact information in a user viewable information database; ....

means for entering the selected contact information into a contact list maintained by a program operating on the portable device.

Tafoya fails to disclose a user interface that presents extracted contact information from a plurality of messages at once prior to any storing of the extracted contact information in a user viewable information database. In contrast, the only time Tafoya appears ever permit the user to view extract information is already after information has been stored in the resolution list. Tafoya does not give a person the opportunity to view extract information before it is stored in a viewable database. Accordingly, claim 12, as amended, overcomes the rejection based on Tafoya. Claims 13 and 15 depend from claim 12 and overcome the rejection for the same reasons.

E. Claim 16

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Independent claim 16, as amended, is directed to a processing system and recites, among other limitations:

a storage device . . . having stored there information for configuring the CPU to:

extract contact information from a number of messages stored in a memory in the portable device; and

enter the extracted contact information into a contact list maintained by a program operating on the portable device, wherein existing contact information is modified with the extracted information or is replaced with the extracted information.

Support for the amendment to claim 16 may be found in at least Paragraph [0034] of the present application. Thus, no new matter is believed to be added.

Tafoya fails to disclose the entering of contact information into a contact list, wherein existing contact information is modified with the extracted information or is replaced with the extracted information. As noted above with respect to the rejection of Claim 1, Tafoya clearly distinguishes a contact list (aka, contact database, address book) from a resolution list. Although Tafoya does disclose transferring information from the resolution list to the contact list, Tafoya only discloses that an entire resolution list entry is added to the contact database. In particular, Tafoya specifically states:

While browsing the resolution list, the user interface preferably allows the user to selectively add entries 550 from the list to his or her address book or contact database.

(Tafoya, column 13, lines 24-27). Nowhere does Tafoya disclose modifying an existing contact list entry or replacing a contact list entry using extracted information. Accordingly, claim 16, as amended, overcomes the rejection based upon Tafoya. Claim 17-20 depend from claim 16 and overcome the rejection for the same reasons.

F. Claim 21

Independent claim 21, as amended, is directed to a system for populating a contact list on a portable device and recites:

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means for extracting contact information from a number of messages stored in a memory in the portable device; and

means for entering the extracted contact information into a contact list maintained by a program operating on the portable device prior to storing any extracted information in any other user viewable information database.

Tafoya fails to disclose or suggest a system having means for extracting contact information from a number of messages stored in a memory and means for entering the extracted information into a contact list prior to storing any of the extracted information in any other user viewable information database. Once again, as noted above, Tafoya requires that extracted information be first stored in its resolution list which is user viewable. Tafoya requires us to occur before the particular information is transferred from the resolution list to the contact database. Accordingly, claim 21, as amended, overcomes the rejection based on Tafoya.

### III. Rejection of Claim 14 under 35 USC 103(a) Based upon Tafoya

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tafoya US Patent 6,829,607. Claim 14 depends from claim 12 and overcomes rejection for the same reasons discussed above with respect to claim 12.

### IV. Added Claims

With this response, claims 22-25 are added. Claims 22-25 are believed to be patentably distinct over the prior art of record.

#### A. Claims 22-24

Claims 22-24 dependent from claims 1, 12 and 16, respectively. Each of such claims specifically recites that the contact list includes contact entries and that each entry is configured to present phone information for a contact. Support for added claims 22-24 may be found in at least Paragraph [00 zero 4] which identifies the OUTLOOK program sold by Microsoft Corp. as an example of a contact list. Applicants further refer to Figures 4-7 which are in a data is being run in Windows. As one aboard a skill the art knows, OUTLOOK has a

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contact list which displays or presents various information including phone numbers of contacts. Thus, no new matter is believed to be added.

Claims 22-24 further clarify and distinguish a contact list from the resolution list described in Tafoya. For the same reasons discussed above with respect to claims 1, 12 and 16, added claims 22-24 are believed to be patentably distinct over the prior art of record.

**B. Claim 25**

Claim 25 constitutes former dependent claim 6 rewritten in independent form to include all of the limitations of former bass claim 1 and former intervening claims 4 and 5. Claim 25 recites that only messages sent or received after a time of a last scan are scanned for contact information extraction.

Tafoya does not disclose a method wherein only messages sent or received after a time of a last scan are scanned for contact information extraction. In rejecting former claim 6, the Office Action asserts that "after the program is started only new entries are dynamically scanned, Col.9, lines 61-63)." As noted above, this assertion is incorrect. As noted above, Tafoya requires the entire "data store" to be scanned each time the program information module (PIM) is started. (See Tafoya, column 9, lines 53-56). Moreover, the portion of Tafoya decided by the Office Action specifically states:

(1)In addition, (2) as the user enters new e-mail addresses or contact information in an e-mail message, or as new e-mail messages having e-mail addresses or contact information are received, that information is also used by the PIM to dynamically update the resolution list.

(Emphasis added) (Tafoya, column 9, lines 59-63). Applicants respectfully note that this dynamic updating of the resolution list is in addition to the already performed complete scan of the entire "data store". Moreover, this statement specifically refers to "as the user enters new e-mail addresses ... or as new e-mail messages ... are received". Such new outgoing e-mail messages or incoming e-mail messages are not disclosed as being scanned from a message database. Accordingly, added claim 25 is presented for consideration and allowance.

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V. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-3815. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-3815. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-3815.

Respectfully submitted,

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